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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/625,967	07/24/2003	James E. Issler	03820-P0094A	1638

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EXAMINER

BRITTAIN, JAMES R

ART UNIT PAPER NUMBER

3677

DATE MAILED: 11/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/625,967

Applicant(s)

ISSLER, JAMES E. 

Examiner

James R. Brittain

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 August 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 19, 21 and 22 is/are allowed.
- 6) ☒ Claim(s) 1-18 and 20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 July 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawing Objections

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the “clasp being a single unit of material” (claim 1; line 6; claim 11, line 3) with reference “from the single unit of material” (claim 11, line 4) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-4 and 6-18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claims 1 and 11 include limitations indicating the “clasp being a single unit of material” (claim 1; line 6; claim 11, line 3) and reference “from the single unit of material” (claim 11, line 4). However, applicant has not indicated in the application as filed that the clasp is a single unit of material as

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opposed to units joined together. These limitations are therefore new matter. The dependent claims include new matter through their dependence on independent claims 1 and 11.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 20 is rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 20 is a method claim depending from claim 19, an article claim, and as such the passage "The method according to claim 19" is unclear as to its scope and meaning. It is suggested that the beginning of the claim be changed to --The lacing system according to claim 19-- and the claim is being interpreted on this assumption.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 2, 4, 6, 9, 11-13, 16, and 18 rejected under 35 U.S.C. 102(e) as being clearly anticipated by Liu (US 6568104).

Liu (figures 10, 11) teaches a lacing system, comprising: a clasp 30' having an anchoring end and a lace end, the lace end adapted to hold a lace; the anchoring end having a first part and

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a second part in the form of resilient legs 332' terminating in hook ends 331' where the first and second parts are movable away from and toward one another; a receiver 40' having a first receptacle and a second receptacle each being a fastener hole 422' for, engaging the first and second parts, respectively; and wherein the clasp is removably joinable to the receiver when the first and second parts are engaged with the first and second receptacles and, when the first and second parts are disengaged with the first and second receptacles, the clasp is separable from the receiver. The clasp 30' is shown in figure 10 as appearing for all purposes to be a single unit of material as there are no separating parts. As to claims 2 and 4, the eyelets 32' comprise loops. In regard to claim 6, the receiver 40' is considered to be a shaft having lateral ends with openings 422' therethrough that are considered to be bored ends. As to claim 9, the receiver 40' is secured to a side of an aperture on the shoe to be closed.

In regard to claim 11, Liu (figures 10, 11) teaches a method for providing an improved lacing system, comprising the steps of: providing a clasp 30' having a receiver end and a lace end; extending a first part and a second part in the form of resilient legs 332' terminating in hook ends 331' from the receiver end; extending a holder in the form of eyelets 32' forming a loop from the lace end; providing a receiver 40' having a first receptacle and a second receptacle each being a fastener hole 422' for receiving the first and second parts, respectively; and wherein the clasp is removably joinable to the receiver for closing an item and the clasp is separable from the receiver for opening the item. The clasp 30' is shown in figure 10 as appearing for all purposes to be a single unit of material as there are no separating parts. As to claims 12 and 13, the steps of engaging the first and second parts with the first and second receptacles removably joins the clasp and receiver of Liu and disengaging the first and second parts with the first and second

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receptacles separates the clasp from the receiver of Liu. As to claim 16, the receiver 40' is secured to a side of an aperture on the shoe to be closed. In regard to claim 18, a lace is obviously passed through the loops of the clasp of Liu.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 3 is rejected under 35 U.S.C. §103(a) as being unpatentable over Liu (US 6568104) in view of De Loureiro Lima (WO 97/40718).

Liu (figures 10, 11) teaches a lacing system, comprising: a clasp 30' having an anchoring end and a lace end, the lace end adapted to hold a lace; the anchoring end having a first part and a second part in the form of resilient legs 332' terminating in hook ends 331' where the first and second parts are movable away from and toward one another; a receiver 40' having a first receptacle and a second receptacle each being a fastener hole 422' for, engaging the first and second parts, respectively; and wherein the clasp is removably joinable to the receiver when the first and second parts are engaged with the first and second receptacles and, when the first and second parts are disengaged with the first and second receptacles, the clasp is separable from the receiver. The clasp 30' is shown in figure 10 as appearing for all purposes to be a single unit of material as there are no separating parts. The difference is that the receiver does not further comprise a hook. However, De Loureiro Lima (figures 1-5) teaches that hooks are well known for securing lacing guides to shoes and provide the added advantage of easier release from the

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shoe. Hooks 3, 6, 11, 19 are utilized on multiple lacing guide structures to show evidence of the desirability of being able to remove the lacing guide from the shoe thereby limiting wear or marring of the shoe. As there are circumstances where it would be desirable to make the release of the lacing guide from the shoe easier than in the device of Liu, it would have been obvious to modify the lace fastener of Liu so that a hook is used upon the receiver to secure it to a shoe as taught by De Loureiro Lima.

Claims 10 and 17 are rejected under 35 U.S.C. §103(a) as being unpatentable over Liu (US 6568104) in view of Weber et al. (US 6240657).

Liu (figures 10, 11) teaches a lacing system, comprising: a clasp 30' having an anchoring end and a lace end, the lace end adapted to hold a lace; the anchoring end having a first part and a second part in the form of resilient legs 332' terminating in hook ends 331' where the first and second parts are movable away from and toward one another; a receiver 40' having a first receptacle and a second receptacle each being a fastener hole 422' for, engaging the first and second parts, respectively; and wherein the clasp is removably joinable to the receiver when the first and second parts are engaged with the first and second receptacles and, when the first and second parts are disengaged with the first and second receptacles, the clasp is separable from the receiver. The clasp 30' is shown in figure 10 as appearing for all purposes to be a single unit of material as there are no separating parts. The difference is that the receiver is not secured to an eyelet of the shoe. However, Weber et al. (figures 7, 8) teaches securing the receiver 59, 60, 69 to the eyelet of the shoe so as to permit the device to be readily used on common shoe structure. As it would be advantageous to readily use the device of Liu on common shoe structure without

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modification of the shoe, it would have been obvious to modify the device of Liu so that the receiver is secured to an eyelet of the shoe as taught by Weber et al. (figures 7, 8) to be desirable.

Claim 5 is rejected under 35 U.S.C. §103(a) as being unpatentable over Liu (US 6568104) in view of Krauss (US 5379496).

Liu (figures 10, 11) teaches a lacing system, comprising: a clasp 30' having an anchoring end and a lace end, the lace end adapted to hold a lace; the anchoring end having a first part and a second part in the form of resilient legs 332' terminating in hook ends 331' where the first and second parts are movable away from and toward one another; a receiver 40' having a first receptacle and a second receptacle each being a fastener hole 422' for, engaging the first and second parts, respectively; and wherein the clasp is removably joinable to the receiver when the first and second parts are engaged with the first and second receptacles and, when the first and second parts are disengaged with the first and second receptacles, the clasp is separable from the receiver. The difference is that the receiver is not cylindrical in shape. However, Krauss (figures 1, 2, 16, 17) teaches that a cylindrical shape is well known in a cord holder for guiding a cord, and applicant is reminded that changes in shape have been found obvious absent evidence that the particular configuration is significant. *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966). It would have been obvious to modify the shape so that the device of Liu is cylindrical in view of Krauss teaching such a shape as being desirable.

Allowable Subject Matter

Claims 19, 21 and 22 are allowed.

Response to Arguments

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Applicant's arguments filed August 13, 2004 have been fully considered but they are not persuasive.

Applicant argues "Claims 1 and 11 require that the clasp be a single unit of material, wherein the anchoring end and lace end are both formed from the single unit of material. U.S. Patent No. 6568104 to Liu does not disclose that the fastener 30' be made of a single unit of material. In fact, figure 10 shows fastener 30' being of multiple pieces." This is unpersuasive because the clasp 30' is shown in figure 10 Liu as appearing for all purposes to be a single unit of material as there are no separating parts only integral extending fingers. Further as indicated above, applicant has not utilized the claimed language in the application as filed and it is therefore new matter.

In response to applicant's argument that Krauss is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case Krauss is concerned with guiding a cord through the end of a separable buckle, similar to guiding a lace through a separable buckle, and the problems confronted in guiding a cord are almost identical to guiding a lace since many laces are in fact cords. Therefore, it is reasonable to inquire into other areas where one of ordinary skill in the art would be aware similar problems exist.

Conclusion

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Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

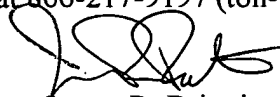
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James R. Brittain whose telephone number is 703-308-2222. The examiner can normally be reached on M, W & F 5:30-1:30, T 5:30-2:00 & TH 5:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J. J. Swann can be reached on 703-306-4115. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



James R. Brittain
Primary Examiner
Art Unit 3677

JRB